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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,674	12/04/2003	Toru Mizutani	09792909-5789	8467

7590 12/18/2007  
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EXAMINER
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GOFF II, JOHN L

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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12/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,674	<b>Applicant(s)</b> MIZUTANI ET AL.	
	<b>Examiner</b> John L. Goff	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 14,26,27 and 29-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14,26,27 and 29-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/768,093.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/07 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

3. Claims 14, 26, 27, 29-32, 34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatta et al. (WO 00/26976 or U.S. Patent 6,797,430) in view of JP 01320769 (See also the abstract).

The body of the rejection is the same as that set forth in paragraph 6 of the office action mailed 3/22/07.

4. Claims 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatta et al. and JP 01320769 as applied to claims 14, 26-32, 34, and 36 above, and further in view of JP 11140209.

The body of the rejection is the same as that set forth in paragraph 7 of the office action mailed 3/22/07.

***Priority***

5. Applicant cannot rely upon the foreign priority papers to overcome Hatta (WO 00/26976 or U.S. Patent 6,797,430) because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. It is noted applicants have filed a certified English translation of JP 10-311482. However, the referred to priority document, JP 10-311482, appears to be incorrect. The priority document, JP 10-311482, is the foreign priority document for Hatta (WO 00/26976 or U.S. Patent 6,797,430) not the instant application. The instant application relies upon foreign priority document, JP P2000-081860. Should applicants perfect the priority of JP P2000-081860 and establish through proper support for the claims a priority date of March 17, 2000 then the rejections over Hatta (PCT WO00/26976 having a publication date of May 11, 2000 or U.S. Patent 6,797,430 having a priority date of December 26, 2000) would be withdrawn.

***Allowable Subject Matter***

6. Claims 14, 26, 27, and 29-36 would be allowed upon the perfection of applicants foreign priority to overcome Hatta (WO 00/26976 or U.S. Patent 6,797,430) for the reasons set forth in paragraph 10 of the office action mailed 3/22/07.

***Response to Arguments***

7. Applicant's arguments filed 10/31/07 have been fully considered but they are not persuasive.

The previous objection to the specification has been overcome by applicants amendment to the specification.

Applicants argue, "Applicant's counsel hereby confirms the invention of the present application was subject to an obligation to assign to the common assignee of *Hatta*, namely Sony Corporation, at the time the present invention was made. Therefore, *Hatta* is not properly used in a rejection under 35 USC §103."

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, because *Hatta* (U.S. Patent 6,797,430) is a U.S. patent resulting directly or indirectly from an international application filed October 29, 1999 the common ownership or assignee prior art exclusion under 35 U.S.C. 103(c) does not apply (MPEP 706.02(I)(1)). In any event, should applicants perfect the priority of foreign priority document, JP P2000-081860, and establish a priority date of March 17, 2000 for the instant application then the rejections over *Hatta* (PCT WO00/26976 having a publication date of May 11, 2000 or U.S. Patent 6,797,430 having a priority date of December 26, 2000) would be withdrawn.

Applicants further argue, "As noted in the specification and declaration, the present application claims priority to Japanese application no. JP 2000-081860. A machine-generated

translation has been submitted in this application. Applicant will submit a certified translation if necessary. JP 2000-081860 has a filing date of March 17, 2000. Accordingly, the present application has an effective filing date of March 17, 2000, which precedes *Hatta's* U.S. filing date.”.

Applicants have submitted a certified English translation of JP 10-311482. However, the referred to priority document, JP 10-311482, appears to be incorrect. The priority document, JP 10-311482, is the foreign priority document for Hatta (WO 00/26976 or U.S. Patent 6,797,430) not the instant application. Applicants should file a certified translation of the priority document JP P2000-081860 to perfect the priority date of the instant application to March 17, 2000 (See MPEP 201.15).

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John L. Goff  
Primary Examiner  
Art Unit 1791